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EXAMINER

LEYSON, JOSEPH S

ART UNIT	PAPER NUMBER
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1722

DATE MAILED: 06/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/842,175

Applicant(s)

PETER ET AL

Examiner

Joseph Leyson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 1-6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 April 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 6) ☐ Other:

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1. Applicant's election with traverse of Group II, apparatus claims 7-16, in Paper No. 5 filed on 28 March 2003 is acknowledged. The traversal is on the ground(s) that the examiner has not shown the inventions of Groups I and II to be distinct, and that examination of both inventions would not be a serious burden on the examiner. This is not found persuasive. The inventions of Groups I and II are distinct. The process as claimed can be practiced by another materially different apparatus, such as an apparatus which does not include a casting container wherein the casting gap is provided by two parallel rollers. The apparatus as claimed can be used to practice another and materially different process, such as a process which does not use a cooling device. The apparatus, as claimed, does not positively require a cooling device (see Claim interpretation below). Further, the apparatus as claimed can be used to practice another and materially different process, such as one which does not use a biopolymer. Note that even the instant disclosure (p. 6) discloses that the apparatus can be used in a process to make products other than biopolymer products, such as detergent capsules or paint balls. Applicant argues that altering the ingredients used by the apparatus would not result in a materially different process. The examiner disagrees. Clearly, a process for making paint balls would be

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distinct from a process for making biopolymer products.

Applicant argues that the apparatus makes reference to a biopolymer. However, such reference is related to the intended use of the claimed apparatus and is not a positive limitation thereof. Intended use has been continuously held not to be germane to determining the patentability of the apparatus, *In re Finsterwalder*, 168 USPQ 530. Purpose to which apparatus is to be put and expression relating apparatus to contents thereof during intended operation are not significant in determining patentability of an apparatus claim, *Ex parte Thibault*, 164 USPQ 666. Inclusion of the material worked upon by a structure being claimed does not impart patentability to the claims, *In re Otto et al.*, 136 USPQ 458. A recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the structural limitation of that claimed, *Ex parte Masham*, 2 USPQ 2d 1647. Applicant argues that examination of both inventions would not be a serious burden on the examiner because searching of the inventions would be co-extensive and because the examiner can use "powerful electronic search engines". However, the search and examination of both inventions would not be coextensive. The issues raised in the examination of apparatus claims are divergent from those raised

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in the examination of process claims. While there may be some overlap in the searches of the two inventions, there is no reason to believe that the searches would be identical. Electronic search engines can be used to search the inventions, but they cannot be used to examine the inventions. Therefore, based on the additional work involved in searching and examining both distinct inventions together, restriction of the distinct inventions is clearly proper.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1-6 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 5 filed on 28 March 2003.

3. The title should be amended in view of the elected invention, i.e., apparatus only.

4. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in

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order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

5. The disclosure should not refer to specific claim numbers, i.e., pp. 1-2, because claim numbering and content can change during prosecution thereof.

6. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP

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§ 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

7. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: 19 (in fig. 2); and 26 (in fig. 3). A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance. In the disclosure, the examiner suggests inserting --19-- after "bearings" on p. 7, lines 11-12; and inserting --26-- after "axes" on p. 7, line 17.

8. The drawings are objected to because "13" does not properly designate the second mass 13. The examiner suggests deleting "13" and its pointing arrow in fig. 1, and re-inserting it to point to the mass in strip casting device 2. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

9. Claim interpretation:

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In claim 7, "in particular of a biopolymer" is understood only to be an example of an intended use of the claimed apparatus, and is NOT a positive limitation. See "intended use" case law above.

Claim 7 recites "wherein the two masses in the flowable condition may together be poured out onto a cooling device" (emphasis added), and thus "a cooling device" is understood NOT to be a positive limitation of the claimed apparatus.

Claim 14 recites "in a manner such that they may intersect with respect to the longitudinal axis" which is understood to mean that the at least two injection nozzles are positively capable of intersecting with respect to the longitudinal axis.

10. Claim 16 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 16 only recites the intended use of the claimed device as a constituent part of a capsule manufacturing machine for manufacturing patterned soft capsules from two flexible strips with the rotary die method. Note that claim 16 recites that "A device according to claim 7" and that the recitations of claim 16 do NOT further limit the structure of the device

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according to claim 7. It appears that applicants are attempting to claim --A capsule manufacturing machine for ... including the device according to claim 7.-- Note that if applicants positively claim --a capsule manufacturing machine-- in an independent claim, a further combination/subcombination restriction requirement may be required.

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 8-14 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Apparatus claims 8-10 are incorrectly dependent upon method claim 1 making claims 8-14 indefinite as to its metes and bounds. Claims 8-10 should be made dependent upon claim 7.

In claim 13, it is unclear whether "the supply tubes" refer to the "feed tubes" of claim 12. The examiner suggests changing "supply" in claim 13 to --feed--.

Claim 16 recites "the rotary die method" which lacks antecedent basis making it unclear to what it refers, and which

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cannot be understood as to what structure is required in an apparatus claim.

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 7-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Schurig et al.(-300).

Schurig et al.(-300) teach a device, that corresponds to the instant device, for manufacturing a flexible strip of at least two different masses flowable with the addition of heat, in particular of a biopolymer, with a casting container 40 which includes at least one casting gap 52 for pouring out at least one first mass 42 and with a feed device for at least one second mass 46 arranged within the casting container 40, wherein the two masses 42, 46 are poured out onto a cooling device 14 in a manner such that they form a certain pattern on the strip (see figs. 4-7), the feed device being a second spreader box 44 having injection nozzles whose openings 56 open out in a region within the casting gap 52 in a manner such that the casting gap 52 partly surrounds the openings 56. The outer surface of the

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second spreader box 44 and the inner surface of the first spreader box 40 form the casting gap 52 (col. 4, lines 51-55; fig. 3). The openings 56 are also partly defined by the same outer surface of the second spreader box 44 (see fig. 3). Thus, the casting gap 52 and the openings 56 partly intersect along an edge, and the casting gap 52 partly surrounds the openings 56. The opening 56 may permit the second mass 46 to flow simultaneously with, immediately prior to, or immediately after formation of the first mass 42 (col. 5, lines 1-5). The second mass 46 is intermittently ejectable out of the injection nozzles by way of a metering device 63. The injection nozzles are movably mounted in the casting container 40 (i.e., see fig. 5). With respect to the longitudinal direction of the casting gap 52, several injection nozzles are arranged next to one another in the casting container 40 which are movable simultaneously or individually (fig. 7; col. 6, lines 19-22 and 40-49). With respect to the width of the casting gap 52, at least two injection nozzles are arranged next to one another (see fig. 8; col. 6, lines 1-11). The injection nozzles are arranged at the ends of feed tubes 60, 68 which are led through a side wall of the casting container 40 and are linkedly mounted on the casting container 40. The feed tubes are movable individually or in groups with a manipulator 62 arranged outside the casting

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container (col. 6, lines 40-49). With respect to the width of the casting gap 52, two injection nozzles are movably arranged next to one another (see fig. 8) in a manner such that they may intersect with respect to the longitudinal axis of the casting gap (col. 6, lines 40-49; col. 7, lines 15-23). The openings of the injection nozzles are displaced back relative to the plane of the casting gap, if the openings permit the second mass to flow immediately prior to formation of the first mass 42 (col. 5, lines 1-5). The device is to be used as a constituent part of a capsule manufacturing machine for manufacturing patterned soft capsules from two flexible strips with a rotary die method (i.e., see fig. 1).

15. Claims 7-12, 15 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Krystof(-646).

Krystof(-646) teaches a device, that corresponds to the instant device, for manufacturing a strip of at least two different masses flowable with the addition of heat, with a casting container 22 which includes a casting gap 30, 32, 36 for pouring out at least one first mass 4 and with a feed device for at least one second mass 6 arranged within the casting container 22, wherein the two masses are poured out in a manner such that they form a certain pattern on the strip (fig. 5), the feed device being a plurality of injection nozzles 116a, 116b whose

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openings open out in a region within the casting gap in a manner such that the casting gap completely surrounds the openings.

The second mass can be intermittently ejectable out of the injection nozzles by way of a metering device (col. 5, lines 55-69). The injection nozzles are movably mounted in the casting container 22 by means 110. With respect to the longitudinal direction and to the width of the casting gap, several injection nozzles are arranged next to one another in the casting container which are movable simultaneously (col. 5, lines 41-54). With respect to the width of the casting gap, several injection nozzles are arranged next to one another. At least one injection nozzle is arranged at the end of feed tubes 60, 56, 74 which are led through a side wall of the casting container 22 and is linkedly mounted on the casting container. The openings of the injection nozzle 116a, 116b are displaced back relative to the plane of the casting gap 36, 32.

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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17. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

18. Claims 7-12, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krystof(-646) in view of Hay, II(-016).

If the "cooling device" of instant claim 7 is a positive limitation, then the following rejection applies.

Krystof(-646) discloses the device substantially as claimed as mentioned above, except for a cooling device.

Hay, II(-016) discloses a cooling device 15 for cooling a newly formed strip.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the device of Krystof(-646) with a cooling device as disclosed by Hay,

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II(-016) because such a modification would cool the newly formed strip.

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Quackenbush et al.(-193), Wight(-311), Shrenk(-703) and Webermeier et al.(-951) are cited as of interest.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Leyson whose telephone number is (703) 308-2647. The examiner can normally be reached on M-F(8:30-6:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker can be reached on (703) 308-0457. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

jl

jl
June 16, 2003

James P. Mackey
JAMES P. MACKEY
PRIMARY EXAMINER

6/16/03